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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/749,399 | 12/28/2000 | Judith C. Espejo | BS00-129 | 5268 |

28970 7590 03/05/2004

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EXAMINER

DAVIS, TEMICA M

| ART UNIT | PAPER NUMBER |
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2681

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DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,399

Applicant(s)

ESPEJO ET AL.

Examiner

Ternica M. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed October 6, 2003 have been fully considered but they are not persuasive.

Applicant argues that McConnell does not show motivation or suggestions for a driven menu system that responds to information of a user, by reciting at least one previous transaction.

The examiner, however, respectfully disagrees. McConnell teaches a system for monitoring telecommunications traffic. The system includes a service control point (SCP) which is connected to a service node. The node contains an intelligent voice response unit (IVRU) that facilitates interaction with users such as playing announcements, speech recognition and collecting DTMF digits from a user (in which the IVRU is inherently based on menu driven functions that allow a user to access various information such as account or billing information) (col. 3, lines 53-62).

As admitted by the examiner, McConnell does not specifically disclose the IVRU reciting a previous transaction to the user in response to receiving information from the user. However, the examiner asserted that such a feature is well known in the art. Further, the suggestion or motivation for this limitation is not only based on well known prior art, but is also found in McConnell (col. 5, lines 59-62). It shows that the system, specifically the SCP, times the user's call, and more importantly, keeps track of the subscriber's account balance. As noted above, the SCP is connected to the IVRU,

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thereby allowing a subscriber to retrieve information from the SCP (such as the billing/account information it tracks) via the IVRU (col. 3, line 53-col. 4, line 16 and col. 5, line 37-col. 6, line 12).

Therefore, based on the well known features of the IVRU, at the time of invention, it would have been obvious to a person of ordinary skill in the art to recite to the user, the tracked billing information since such information is known to the SCP, which is connected to the IVRU, and wherein the IVRU can accept requests from a user (through DTMF, col. 3, lines 53-62), and inherently recite the desired request of the user.

As further evidence of an IVRU reciting previous transactions (i.e., tracked billing/account information) to a user based on the users request, Block et al, U.S. Patent No. 6,377,938, discloses how a user can be informed of charges accumulated to date or the remaining balance of an account by pressing predetermined sequence buttons on a phone keypad and receiving a response via a Voice Response System (col. 9, lines 5-14).

As stated in the previous office action, such a feature would have been beneficial to a user in order to help the user keep track of actions performed in the system.

Based on the above remarks, the rejection stands.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McConnell et al (McConnell), U.S. Patent No. 6,373,930.

Regarding claim 1, McConnell discloses an interactive voice response system for pre-paid wireless services (col. 4, lines 17-27) comprising: a peripheral device in communication with a mobile switching system (col. 3, line 53-col. 4, line 11), the mobile switching system capable of communicating with at least one wireless device (col. 4, lines 1-27), an IVR application on the peripheral device comprising inherently a menu driven system adapted to receive information from a customer, wherein the menu driven system responds to the information received from the customer (col. 3, lines 53-62, col. 5, lines 59-62, col. 6, lines 30-41).

McConnell, however, fails to disclose wherein at least one previous transaction is recited.

The examiner, however, contends that at the time of invention such a feature would have been obvious since as shown in the above passages that a subscriber can interact with a voice response system to receive and transmit subscriber related information. Further, previous transactions transmitted to the user would be beneficial to the user in order to help the user keep track of actions performed in the system.

Regarding claim 2, McConnell discloses the interactive voice response system of claim 1, wherein the peripheral device includes an IP (col. 4, lines 1-10).

Regarding claim 3, McConnell discloses the interactive voice response system of claim 1, wherein the peripheral device includes an SCP (col. 4, lines 10-16).

Regarding claim 4, McConnell discloses the interactive voice response system of claim 1 as described above.

McConnell, however, fails to disclose, wherein the menu drive system includes security provisions that permit customers to only access information related to their own personal accounts.

The examiner contends, however, that at the time of invention, such a feature would have been obvious to a person of ordinary skill in the art in order to ensure that information of other system users are not tampered with.

Regarding claim 5, McConnell discloses the interactive voice response system according to claim 1, wherein the menu driven system application resides on an SCP and communicates with the mobile switching system using IN TCAP messaging (col. 2, lines 44-52). Regarding claim 6, McConnell discloses the interactive voice response system according to claim 5, wherein the menu driven system on the SCP communicates with an Intelligent Peripheral using TCP/IP (col. 4, lines 10-16).

Regarding claim 7, McConnell discloses the interactive voice response system according to claim 5, wherein the menu driven system on the SCP communicates with an Intelligent Peripheral using IN TCAP messaging over CSS7 Network, and wherein the Intelligent Peripheral plays voice messages and communicates with the mobile switching system through a voice path (col. 2, lines 39-65).

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Regarding claims 8, McConnell discloses the interactive voice response system according to claim 1, wherein the transaction is a call (col. 5, lines 3-14).

Regarding claim 12, McConnell discloses the interactive voice response system according to claim 1, wherein the transaction is a replenishment (col. 5, lines 1-11).

Regarding claims 9-11, 13 and 14, McConnell discloses the interactive voice response system according to claims 8 and 12 as described above. McConnell, however, fails to disclose the specific recitations as described in claims 9-11, 13 and 14.

McConnell does, however, teach that the IVR system can play announcements (col. 3, lines 56-63). Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to implement announcements that recite the information as described in claims 9-11, 13 and 14 in order for the user of the system to hear the status of their account.).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached Monday–Friday (alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (703) 305-4040. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Temica M. Davis
Examiner
Art Unit 2681

TMD
March 2, 2004


SINH TRAN
PRIMARY EXAMINER


TEMICA M. DAVIS
PATENT EXAMINER